UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,685	10/24/2001	Travis J. Parry	10006365-1	8293

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EXAMINER
POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 May 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Applicant's amendment was received on 5/2/05, and has been entered and made of

record. Currently, **claims 1-28** are pending.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   **Claims 1-12, 19-21, and 28** are rejected under 35 U.S.C. 102(e) as being anticipated by

Tonkin (U.S. Patent Number 6,134,568).

Regarding *claim 1*, Tonkin discloses a method of automated printing of an image at a

user printer (see abstract), with the method comprising arranging a user printer (document

production locations 71-73) and a sender (terminals 31-32) to be independent of and separate

from each other (see Fig. 1), and arranging the user printer (document production locations 71-

73) to be independent of and separate from a network site (processing facility 60, see Fig. 1),

defining a print criterion for the user printer (column 8, lines 10-30, and column 9, lines 5-23),

registering the user printer with the network site to make at least one automatic image request

from the user printer to the network site for printing at least one image at the user printer

(column 13, line 26-column 14, line 23), determining, via a network communication link

between the user printer and the network site, whether the at least one image has been posted at

the network site by the sender (column 13, lines 1-41), capturing the at least one image from the

network site to the user printer upon determining that the at least one image has been posted at

the network site (column 14, lines 24-column 15, line 24), and automatically printing the at least

one image on the user printer according to the print criterion (column 9, lines 5-42, and column

13, lines 17-column 14, line 50).

Regarding *claim 2*, Tonkin discloses the method discussed above in claim 1, and further

teaches that registering the user printer includes defining a printer network address (column 13,

line 42-column 14, line 8), and wherein defining the printer network address includes defining a

unique address associated with the user printer and registering the printer network address with

the network site (column 3, lines 57-column 4, line 24, and column 13, line 42-column 14, line

8).

Regarding *claim 3*, Tonkin discloses the method discussed above in claim 2, and further

teaches that the defining the network address includes defining the unique address associated

with the user printer as an IP address (column 3, lines 19-24, wherein the network addresses of

the document production locations connected over the Internet would inherently have IP

addresses).

Regarding *claim 4*, Tonkin discloses the method discussed above in claim 1, and further

teaches of defining a user interface, and wherein defining the print criterion includes defining the

print criterion via the user interface (column 7, line 39-column 8, line 36).

Regarding *claim 5*, Tonkin discloses the method discussed above in claim 4, and further teaches that the print criterion includes registering at least one of user information, sender information, printing options, and image delivery options (column 7, line 11-column 8, line 60).

Regarding *claim 6*, Tonkin discloses the method discussed above in claim 5, and further teaches that registering the user information and registering the sender information includes providing usernames and passwords for a user and a sender (column 13, lines 1-24), together with the printer network address and the network site address (column 13, line 52-column 14, line 23), wherein capturing the image from the network site to the user printer includes logging on to the network site identified by the network site address with the username and the password of the user, and the image being transferred from the network site to the user printer identified by the printer network address (column 13, line 1-column 14, line 59).

Regarding *claim 7*, Tonkin discloses the method discussed above in claim 5, and further teaches that registering the printing options includes selecting at least one of a file format input, a file format output, a print medium size, a print medium type, a number of copies, a printing layout, a color printing option, and a finishing option (column 7, line 11-column 8, line 60).

Regarding *claim 8*, Tonkin discloses the method discussed above in claim 5, and further teaches that registering the image delivery options includes selecting at least one delivery option, a gallery, and an image size (column 7, line 11-column 8, line 60).

Regarding *claim 9*, Tonkin discloses the method discussed above in claim 1, and further teaches that registering the user printer includes defining a network communications link between the user printer and the network site, and registering the user printer with the network

site via the network communications link (column 3, lines 57-column 4, line 24, and column 13, line 42-column 14, line 8).

Regarding *claim 10*, Tonkin discloses the method discussed above in claim 1, and further teaches that defining the network site to be a website (column 13, lines 1-24).

Regarding *claim 11*, Tonkin discloses the method discussed above in claim 10, and further teaches that registering the user printer at the website includes defining the user printer to include a printing system controller and a web access mechanism (column 13, line 1-column 14, line 8).

Regarding *claim 12*, Tonkin discloses the method discussed above in claim 9, and further teaches that capturing the at least one image from the network site to the user printer and automatically printing the at least one image on the user printer include capturing the image via the network communications link (see abstract and column 13, line 42-column 14, line 8).

Regarding *claim 19*, Tonkin discloses the method discussed above in claim 1, and further teaches that automatically printing the at least one image on the user printer includes translating the at least one image captured from the network site into a print job (column 13, line 17-column 14, line 59).

Regarding *claim 20*, Tonkin discloses the method discussed above in claim 19, and further teaches that automatically printing the at least one image on the user printer further includes executing the print job by printing the at least one image on the user printer and thereby delivering the at least one image to the user (column 13, line 17-column 14, line 59).

Regarding *claim 21*, Tonkin discloses a method of automated printing of a digital photograph (see abstract, column 2, lines 27-61), with the method comprising registering a user

printer at a website (column 13, line 1-column 14, line 23), the user printer (document

production locations 71-73) being independent of and separate from the website (processing

facility 60, see Fig. 1), posting, via a sender (terminals 31-32) independent of the user printer and

the website (see Fig. 1), at least one digital photograph at the website (column 13, lines 1-41),

requesting, via a network communication link between the user printer and the website, the at

least one digital photograph from the website for printing at the user printer (column 14, lines

24-column 15, line 24) including, determining, via the network communication link, whether the

at least one digital photograph has been posted to the website (column 13, lines 1-41), capturing,

via the network communication link, the at least one digital photograph from the website to the

user printer after the at least one digital photograph has been posted to the website by the sender

(column 14, lines 24-column 15, line 24), and automatically printing the at least one digital

photograph on the user printer (column 9, lines 5-42, and column 13, lines 17-column 14, line

50).

Regarding *claim 28*, Tonkin discloses a computer-readable medium having computer-

executable instructions (column 15, lines 4-35) for performing a method of automated printing of

an image at a user printer (see abstract), with the method comprising arranging a user printer

(document production locations 71-73) and a sender (terminals 31-32) to be independent of and

separate from each other (see Fig. 1), and arranging the user printer (document production

locations 71-73) to be independent of and separate from a network site (processing facility 60,

see Fig. 1), defining a print criterion for the user printer (column 8, lines 10-30, and column 9,

lines 5-23), registering the user printer with the network site to make at least one automatic

image request from the user printer to the network site for printing at least one image at the user

printer (column 13, line 26-column 14, line 23), determining, via a network communication link

between the user printer and the network site, whether the at least one image has been posted at

the network site by the sender (column 13, lines 1-41), capturing the at least one image from the

network site to the user printer upon determining that the at least one image has been posted at

the network site (column 14, lines 24-column 15, line 24), and automatically printing the at least

one image on the user printer according to the print criterion (column 9, lines 5-42, and column

13, lines 17-column 14, line 50).

4.   **Claims 1 and 13-18** are rejected under 35 U.S.C. 102(e) as being anticipated by Kelley *et*

al. (U.S. Patent Number 6,320,671).

Regarding *claim 1*, Kelley discloses a method of automated printing of an image at a user

printer (column 3, lines 38-61), with the method comprising arranging a user printer (printer 30)

and a sender (client computer 10) to be independent of and separate from each other (see Fig. 1),

and arranging the user printer to be independent of and separate from a network site (network

server 18, see Fig. 1), defining a print criterion for the user printer (column 6, line 42-column 7,

line 9), registering the user printer with the network site to make at least one automatic image

request from the user printer to the network site for printing at least one image at the user printer

(column 3, line 38-61, and column 4, line 29-column 5, line 33), determining, via a network

communication link between the user printer and the network site, whether the at least one image

has been posted at the network site by the sender (column 6, line 65-column 7, line 9), capturing

the at least one image from the network site to the user printer upon determining that the at least

one image has been posted at the network site (column 3, lines 38-60, and column 4, lines 29-

67), and automatically printing the at least one image on the user printer according to the print criterion (column 3, lines 38-61, and column 5, lines 19-33).

Regarding *claim 13*, Kelley discloses the method discussed above in claim 1, and further teaches that determining whether the at least one image has been posted to the network site includes defining a master image list as a list of downloaded images from the network site and comparing the master image list with the at least one image posted to the network site (column 5, line 11-column 7, line 9).

Regarding *claim 14*, Kelley discloses the method discussed above in claim 13, and further teaches that comparing the master image list with the at least one image posted to the network site further includes retrieving an image list of images posted to the network site (column 5, line 11-column 7, line 9).

Regarding *claim 15*, Kelley discloses the method discussed above in claim 14, and further teaches that retrieving the image list includes the user printer sending a query to the network site according to the print criterion via the network communications link (column 5, line 11-column 7, line 9).

Regarding *claim 16*, Kelley discloses the method discussed above in claim 15, and further teaches that comparing the master image list with all images posted to the network site includes comparing the master image list with the image list retrieved from the network site, generating via the printing system controller an image request, as part of the at least one automatic image request, that identifies the image to be printed, and updating the master image list to include the image after it has successfully been delivered to the user (column 5, line 11-column 7, line 9).

Regarding *claim 17*, Kelley discloses the method discussed above in claim 16, and further teaches that capturing the image from the network site includes the at least one image being transferred from the network site to the user printer according to the image request via the network communications link (see Fig. 1).

Regarding *claim 18*, Kelley discloses the method discussed above in claim 17, and further teaches that the at least one image being transferred from the network site to the user printer includes the network site receiving the image request from the user printer via the network communication link (see Fig. 1, and column 5, line 11-column 7, line 9).

5.   **Claims 22-27** are rejected under 35 U.S.C. 102(e) as being anticipated by Garcia (U.S. Patent Application Publication US 2003/0048470).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding *claim 22*, Garcia discloses a system for automated printing of an image posted at a user printer (see abstract and Figs. 2 and 3), the system comprising a user printer (printer 12) including an embedded web access mechanism (web browser 23) and a printing system controller (controller 150, see Fig. 3), the embedded web access mechanism configured to enable directly automatically requesting and directly automatically capturing to the user printer at least

one image that has been posted to a network site by a sender (paragraphs 0022-0025), the user

being independent of and separate from both the sender and the network site (see Fig. 2), and a

user interface in communication with the user printer and configured to enable predefined a print

criterion (paragraphs 0026, and 0033-0037), wherein the user printer is configured to

automatically print the captured image at the user printer according to the print criterion

(paragraphs 0033-0039).

Regarding *claim 23*, Garcia discloses the system discussed above in claim 22, and further

teaches that the user printer contains the user interface and the embedded web access mechanism

includes an embedded application allowing the user printer to communicate with the network site

regardless of the network site's operating platform (paragraphs 0016-0017).

Regarding *claim 24*, Garcia discloses the system discussed above in claim 23, and further

teaches that the printing system controller includes a processor, a memory, device-specific

hardware, and input/output circuitry, wherein the embedded web access mechanism includes a

printer web page, a printer web server, and a network interface (see Figs. 2 and 3, paragraphs

0019-0029).

Regarding *claim 25*, Garcia discloses the system discussed above in claim 24, and further

teaches that the web server is adapted to generate the printer web page, wherein the printer web

page is configured to provide the user interface, and wherein the user interface is configured to

provide a control communications link to the printing controller for defining the print criterion

(paragraphs 0033-0036).

Regarding *claim 26*, Garcia discloses the system discussed above in claim 21, and further

teaches that the printer is configured to communicate with the network site via the network

communications link for registering the user printer with the network site, determining if the image has been posted to the network site, and capturing the image from the network site to the user printer (paragraphs 0031-0039).

Regarding *claim 27*, Garcia discloses the system discussed above in claim 24, and further teaches that the embedded web access mechanism is configured to permit access to the printer web page by the network site via the network communications link (paragraphs 0033-0039).

Conclusion

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
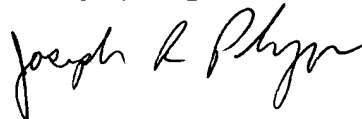
7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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jrp